



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,534	01/25/2001	Paul D. Coleman	12610-003002	6783

7590

09/20/2002

LEE CREWS, PH.D.  
Fish & Richardson P.C.  
225 Franklin Street  
Boston, MA 02110-2804

EXAMINER

SAKELARIS, SALLY A

ART UNIT

PAPER NUMBER

1634

DATE MAILED: 09/20/2002

16

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/770,534

Applicant(s)

COLEMAN ET AL.

Examiner

Sally A Sakelaris

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 57-100 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 57-100 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **Restrictions**

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 57-75, 87-92, and 99 are drawn to a method for creating a gene profile by determining the level of expression of one or more of the mRNAs, classified in class 435, subclass 6.
  - II. Claims 76-86, 93-98, and 100 are a method for creating a gene profile by determining the level of expression of one or more types of proteins, classified in class 435, subclass 7.1.
2. The inventions are distinct, each from the other because of the following reasons:
  - a. Inventions I and II are drawn to patentably distinct methods which involve different method steps, include different reagents and have different objectives. Invention I involves determining the level of expression of one or more of the mRNAs. The invention of Group II is drawn to a method determining the level of expression of one or more types of proteins. The mRNAs of Invention I are composed of nucleotides whereas the proteins of Invention II are composed of amino acids. Inventions I and II include methods that cater to biomolecules with different structural and functional properties and as a result each requires different method steps, different reagents, and have different objectives. Therefore the methods are distinct over one another.

### **Restriction Requirement Applicable to All Groups:**

3. Each sequence is patentably distinct because they are unrelated sequences, i.e. these sequences are unrelated because the protein encoded by these sequences differs in structure and

in function and in biological activity. A restriction is applied to each Group. For an elected Group drawn to determining the level of expression of a mRNA , the Applicants must elect a single mRNA encoding(from claims 65-72, and 88-89). For example, if Group I is elected, applicant must further elect one of the mRNAs encoding, like that of a "cell cycle regulator." Similarly, for an elected Group drawn to determining the level of expression of a protein, applicant must further elect a single expressed protein and antibody with which they may detect the single protein(from claims 83-84 and 94-95). For example, if applicant elects Group II, they must further elect a single protein and antibody that each correspond to for instance, a cell cycle regulator (See MPEP 803.04).

Applicant should note that generic claims will be examined to their full scope while claims which recite particular mRNAs or proteins will be examined with regard to the elected invention.

The search of the selected sequence may include the complements of the selected sequences and, where appropriate, may include subsequences within the selected sequences (e.g., oligomeric probes and/or primers).

Nucleotide sequences encoding different proteins are structurally distinct chemical compounds and are unrelated to one another. Similarly, proteins comprising unique amino acid sequences are structurally and functionally distinct. These sequences are thus deemed to normally constitute independent and distinct inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequences are presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 et seq.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by the different classifications and their divergent subject matter and because these inventions require different searches that are not co-extensive, examination of these distinct inventions would pose a serious burden on the examiner and therefore restriction for examination purposes as indicated is proper.

5. Applicant is advised that the reply to this requirement, to be complete, must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Application/Control Number: 09/770,534  
Art Unit: 1634


Page 5

7. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Sally Sakelaris whose telephone number is (703) 306-0284. The examiner can normally be reached on Monday-Friday from 8:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W.Gary Jones, can be reached on (703)308-1152. The fax number for the Technology Center is (703)305-3014 or (703)305-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to Chantae Dessau whose telephone number is (703)605-1237.

Sally Sakelaris

  
9/27/02

  
CARLA J. MYERS  
PRIMARY EXAMINER

~~CARLA J. MYERS~~  
~~PRIMARY EXAMINER~~